



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Serial No.: 09/434,394 Confirmation No.: 3898  
Applicant: John S. Yates, Jr., et al.  
Title: DETECTING REORDERED SIDE EFFECTS  
Filed: November 4, 1999  
Art Unit: 2122  
Examiner: Nguyen Ba, H. V. A  
  
Atty. Docket: 114596-20-4009  
Customer No. 38492

**AFTER FINAL – EXPEDITED PROCEDURE**

**REQUEST FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION**

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Applicant observes that the Advisory Action of March 28, 2005 raises a new ground of rejection. All issues raised in the “final” Office Action of December 30, 2004 are apparently resolved. Pursuant to MPEP § 706.07(c) and (d), Applicant requests that the finality of the Action of December 30, 2004 be withdrawn, and that the Request for Reconsideration filed herewith be entered as of right.

**I. The Advisory Action Introduces a New Ground of Rejection of an Unamended Claim**

An Action may not be made final when it introduces a new ground of rejection, where the new ground was not necessitated by an amendment. MPEP § 706.07(a).

I certify that this correspondence, along with any documents referred to therein, is being transmitted by facsimile on April 14, 2005 to Art Unit 2122 at FAX no. 703 872 9306, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

A “new ground of rejection” is any new line of reasoning that requires a “fair opportunity to react to the thrust of the rejection.” *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426 (CCPA 1976). For example, relying on new portions of the same references, for disclosure not found in portions previously relied on, is a “new ground of rejection.” *In re Wiechert*, 370 F.2d, 927, 933, 152 USPQ 247, 251-52 (CCPA 1967) (“An applicant's attention and response are naturally focused on that portion of the reference which is specifically pointed out by the examiner. ... [W]hen a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-à-vis such portion of the reference,” emphasis added). Any new reference is a new ground of rejection. *In re Ahlert*, 424 F.2d 1088, 1092 n. 4, 165 USPQ 418, 421 n. 4 (CCPA 1970) (any time a new reference is cited, “a new ground of rejection is always stated,” emphasis added).

The Advisory Action introduces both a new reference and a new portion of a reference. The Advisory Action is the first time U.S. Patent No. 6,789,181 has been mentioned. This is a “new ground of rejection.” Further, the Advisory Action is the first to identify any similarity between claim 1 of this application and any identified combination of claims 16, 18 and 19 of U.S. Pat. No. 6,789,181. This “different portion” of the '181 patent is likewise a “new ground of rejection.”

Claim 1 of this application was not amended subsequent to the Office Action of December 30, 2004.

Any double patenting rejection raised in the Advisory Action is a “new ground of rejection” of an unamended claim.

Thus, under MPEP § 706.07(a), this new ground of rejection cannot be made final.

## **II. The Advisory Action Applies an Incorrect Test for Consideration of Applicant's Paper of February 28, 2004**

The Advisory Action of March 28, 2005 has a check in the box for “The proposed amendment(s) filed after a final rejection... will not be entered because ... they raise new issues that would require further consideration and/or search.” The Advisory Action does not check any box relevant to “Request for Reconsideration.”

Applicant's paper of February 28, 2005 was not an "amendment;" it proposed no amendment(s). It was only a Request for Reconsideration. The Remarks of February 28, 2005 and of the Request for Reconsideration filed herewith are entitled to full consideration.

### III. Conclusion

For these reasons, the finality of the Action of May 10, 2002 should be withdrawn, and the Remarks in the accompanying Request for Reconsideration should be given the Examiner's full consideration.

In the event final rejection is withdrawn, the Information Disclosure Statement filed February 28, 2005 is entitled to consideration.

It is believed that this paper occasions no fee. Kindly charge any fee due to Deposit Account No. 23-2405, Order No. 114596-20-4009.

Respectfully submitted,

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Dated: April 14, 2005

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**SECOND REQUEST FOR RECONSIDERATION (WITHOUT AMENDMENT)**

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Applicant hereby responds to the Advisory Action of March 28, 2005.

**CONDITIONAL PETITION FOR EXTENSION OF TIME**

Applicant believes that the Advisory Action of March 28, 2005 raises a “new ground of rejection,” and thus the finality of the Office Action of December 2004 is withdrawn by operation of law. Applicant submits that the Request for Reconsideration of February 28, 2005 tolled the period for response, and that no further extension of time is necessary.

In the event that the Office disagrees, Applicant petitions for a one-month extension of time to respond to the Office Action of December 30, 2004, which extends the period for

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